

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Calvin Charles Shaw

Serial No.: 10/711,650

Filed: September 29, 2004

Title: Method and Apparatus for Framing
Greeting Cards

§ Group Art Unit: 3611
§
§ Confirmation No.: 5649
§
§ Examiner: Silbermann, Joanne
§
§ Attorney Docket No. 5404-04-1
§
§

Certificate of Mailing Under 37 C.F.R. § 1.8(a)

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By: Michael R. Nichols
Michael R. Nichols

APPELLANT'S BRIEF (37 CFR § 41.37)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A. INTRODUCTORY COMMENTS

This brief is submitted in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on August 8, 2006 and in furtherance of the Notice of Appeal filed in this case on April 7, 2006.

B. REAL PARTIES IN INTEREST

The real party in interest in this appeal is Calvin Charles Shaw, an individual.

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C. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

D. STATUS OF CLAIMS*1. Total number of claims in application*

The claims in the application are: 1-20

2. Status of all claims in application

- Claims canceled: None
- Claims withdrawn from consideration but not canceled: None
- Claims pending: 1-20
- Claims allowed: None
- Claims rejected: 1-20

3. Claims on appeal

The claims on appeal are: 1-20

E. STATUS OF AMENDMENTS

All amendments have been entered in this case.

F. SUMMARY OF INVENTION

The present invention provides an apparatus for framing a greeting card in a manner that allows relatively simple access to the entire contents of the card, while still providing protection and a decorative presentation for the card. A preferred embodiment of the present invention includes a first mat, a second mat, and a mount board, each of which is equipped with magnetic surfaces to allow all three pieces to hold together when mounted in a picture frame. [Para 28, Fig. 7]. The first mat resembles a conventional mat used in framing art. [Para 20, Fig. 2A]. The second mat, which is held in place magnetically to the back of the first mat, contains two vertical slits that are sized to allow a greeting card to be threaded through the slits and thus mounted to the second mat. [Para 23, Fig. 3]. A self-adhesive magnet is provided for attaching to the card's envelope, and the second mat includes an additional magnetic surface that may be used to attach the card's envelope to the second mat. [Para 24, Fig. 3]. The mount board is placed behind the

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second mat and is held in place magnetically to the second mat. [Para 26, Fig. 5]. A pull tab extends from the front of the mount board to allow the mount board to be readily detached from the second mat to allow access to the card. [Para 27, Fig. 5].

G. ISSUES

1. Whether claims 1-3 and 9-12 are obvious under 35 U.S.C. § 103 in view of US 4,391,053 (*Anthony*) and US 4,849,056 (*Ristuccia*).
2. Whether claims 4-8 and 13-20 are obvious under 35 U.S.C. § 103 in view of US 4,391,053 (*Anthony*), US 4,849,056 (*Ristuccia*), and US 5,524,373 (*Plumly*).

H. GROUPING OF CLAIMS

The claims do not stand or fall together. The claims are grouped as follows:

Group I: Claims 8 and 18

Group II: Claims 1-7, 9-17, and 19-20

I. ARGUMENT

35 U.S.C. § 103, Obviousness, Group I (Claims 8 and 18)

The Examiner has rejected claims 8 and 18 under 35 U.S.C. § 103 as being unpatentable over US 4,391,053 (*Anthony*) in view of US 4,849,056 (*Ristuccia*) and US 5,524,373 (*Plumly*). **Appellants respectfully submit that claims 8 and 18 were improperly rejected as the references neither teach nor suggest all of the elements of these claims.**

A. Burden

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The Examiner has failed to meet that burden for the following reasons.

B. References must teach or suggest all elements of the rejected claims

For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With regard to claims 8 and 18, the references fail to teach or suggest all elements of these claims. Claim 8 includes the limitation of attaching a magnetic surface to an envelope associated with the work and magnetically affixing the envelope associated with the work to the sheet of material.¹ Claim 18 includes the limitation of a first detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an envelope associated with the work.² These limitations are neither taught nor suggested by the cited references.

In fact, neither of these limitations was addressed by the Examiner at all in either of the two Office Actions entered in this case (*i.e.*, the November 7, 2005 Office Action and the February 2, 2006 Final Office Action). The Examiner's rejection in view of *Anthony, Ristuccia*, and *Plumly* fails to address claims 8 and 18 individually and fails to identify any teaching or suggestion of attaching an *envelope associated with a framed work* using a magnetic surface or other detachable attachment surface. While the Examiner notes that the *Plumly* reference discusses the use of magnetic surfaces to frame an advertisement using a mat, the Examiner did not argue that *Plumly* or any other cited reference teaches or suggests the additional use of magnetic surfaces to attach additional items associated with a framed work, such as an envelope.

Moreover, none of the three cited references contains any teaching or suggestion relating to the use of detachable attachment surfaces or magnetic surfaces to attach an envelope associated with a framed work. In fact, the word "envelope" does not even appear in any of the three cited references.

For these reasons, Applicant respectfully submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness with respect to claims 8 and 18. Therefore, the rejection of those claims should be reversed.

35 U.S.C. § 103, Obviousness, Group II (Claims 1-7, 9-17, and 19-20)

The Examiner has rejected claims 1-3 and 9-12 under 35 U.S.C. § 103 as being unpatentable over US 4,391,053 (*Anthony*) in view of US 4,849,056 (*Ristuccia*). The Examiner

¹ Specifically, claim 7 recites "attaching a magnetic surface to an item associated with the work; and magnetically affixing the item to the sheet of material," and claim 8 recites "The method of claim 7, wherein the item is an envelope."

² Specifically, claim 16 recites "a detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an item associated with the work," and claim 18 recites "The apparatus of claim 16, wherein the item is an envelope."

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has rejected claims 4-7, 13-17, and 19-20 under 35 U.S.C. § 103 as being unpatentable over US 4,391,053 (*Anthony*) in view of US 4,849,056 (*Ristuccia*) and US 5,524,373 (*Plumly*).

A. No Motivation to Combine References

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In support of her rejection of the independent claims, claims 1 and 11, the Examiner asserts that one skilled in the art would be motivated to combine the full-length slits of *Ristuccia* (used for holding business cards) with the frame and mat of *Anthony* “so as to provide a more secure holding means for the work.” (Final Office Action at 2). This is not a proper motivation to combine the references, however, because the *Ristuccia* slits, which are vertical, do not, in fact, provide a more secure holding means for the work than do the *Anthony* slits, which are positioned at the four corners of the work being framed. The *Anthony* device holds the work in such a way that it cannot be moved horizontally or vertically. *Ristuccia*’s device, on the other hand, only restrains a business card vertically: if one tries to slide a business card mounted in the *Ristuccia* device from side to side, the card will slide out. Therefore, the motivation to combine these two references proposed by the Examiner simply does not exist.

The other rejected claims, having dependency on claims 1 and 11 are patentable for the same reasons set forth with respect to claims 1 and 11.

Respectfully submitted,
By Michael R. Nichols
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J. APPENDIX OF CLAIMS

Claim 1 (previously presented): A method of framing a work, comprising:

threading the work through a plurality of slits in a sheet of material, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits;
positioning the sheet of material within a picture frame; and
attaching a backing behind the sheet of material.

Claim 2 (original): The method of claim 1, further comprising:

positioning a mat within the picture frame such that the work is exposed through an opening in the mat.

Claim 3 (original): The method of claim 2, further comprising:

affixing the mat to the picture frame with mounting points.

Claim 4 (original): The method of claim 3, wherein at least a portion of a surface of the mat is covered in a magnetic material.

Claim 5 (original): The method of claim 4, wherein at least a portion of the sheet of material is covered in a magnetic material and wherein positioning the sheet of material within the picture frame includes magnetically affixing the sheet of material to the mat.

Claim 6 (original): The method of claim 5, wherein the backing comprises a mount board, wherein at least a portion of a surface of the mount board is covered in a magnetic material, and wherein attaching the backing includes magnetically affixing the mount board to the sheet of material.

Claim 7 (original): The method of claim 5, further comprising:

attaching a magnetic surface to an item associated with the work; and magnetically affixing the item to the sheet of material.

Claim 8 (original): The method of claim 7, wherein the item is an envelope.

Claim 9 (original): The method of claim 1, wherein the work is a document.

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Claim 10 (original): The method of claim 9, wherein the document is a greeting card.

Claim 11 (previously presented): An apparatus for framing a work, comprising:

a picture frame;

a first mat, wherein the first mat contains an opening that is sized to allow the work to be viewed through the opening;

a second mat, wherein the second mat contains a plurality of slits that are sized and positioned to allow the work to be held into place upon the second mat by threading the work through the slits, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits; and

a mount board that is positioned relative to the picture frame, first mat, and second mat so as to enclose the first mat and second mat between the picture frame and mount board.

Claim 12 (original): The apparatus of claim 11, wherein the first mat is held into the picture frame with a plurality of mounting points.

Claim 13 (original): The apparatus of claim 12, wherein the first mat, second mat, and mount board each include detachable attachment surfaces and wherein the first mat, second mat, and mount board are attached to each other in a layered configuration in which the detachable attachment surfaces hold the first mat, second mat, and mount board together in the layered configuration.

Claim 14 (original): The apparatus of claim 13, wherein the detachable attachment surfaces are magnetic surfaces.

Claim 15 (original): The apparatus of claim 13, further comprising:

a ribbon attached to the mount board, wherein the mount board may be detached from the second mat by pulling the ribbon.

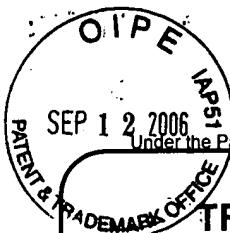
Claim 16 (previously presented): The apparatus of claim 11, wherein the first mat, the second mat, or the mount board includes a first detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an item associated with the work.

Claim 17 (original): The apparatus of claim 16, wherein the first detachable attachment surface and second detachable attachment surface are magnetic surfaces.

Claim 18 (original): The apparatus of claim 16, wherein the item is an envelope.

Claim 19 (original): The apparatus of claim 11, wherein the work is a document.

Claim 20 (original): The apparatus of claim 19, wherein the document is a greeting card.



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

10

Application Number	10/711,650
Filing Date	September 29, 2004
First Named Inventor	Calvin Charles Shaw
Art Unit	3611
Examiner Name	Silbermann, Joanne
Total Number of Pages in This Submission	10
Attorney Docket Number	5404-04-1

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please Identify below):
<input type="checkbox"/> Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Law Office of Michael R. Nichols		
Signature			
Printed name	Michael R. Nichols		
Date	September 7, 2006	Reg. No.	46,959

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Typed or printed name	Michael R. Nichols	Date	September 7, 2006

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

250

Complete if Known	
Application Number	10/711,650
Filing Date	September 29, 2004
First Named Inventor	Calvin Charles Shaw
Examiner Name	Silbermann, Joanne
Art Unit	3611
Attorney Docket No.	5404-04-1

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____
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 Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description

	Small Entity
Each claim over 20 (including Reissues)	50 25
Each independent claim over 3 (including Reissues)	200 100
Multiple dependent claims	360 180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
- 20 or HP = _____	x _____	= _____	Fee (\$)	Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
- 3 or HP = _____	x _____	= _____	Fee (\$)	Fee Paid (\$)

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____	/ 50 = _____ (round up to a whole number)	x _____	= _____	Fee Paid (\$)

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Fee for filing Appeal Brief

250

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 46,959	Telephone 972-369-1300
Name (Print/Type)	Michael R. Nichols		Date September 7, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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